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REMARKS

This is a full and timely response to the non-final Official Action mailed 22 August 2007. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

By the forgoing amendment, the specification and various claims have been amended. No claims are cancelled, and new claims 24 and 25 have been added. Thus, claims 1-25 are currently pending for further action.

Objection to Declaration:

On the Office Action Summary page of the recent Office Action, box 11 is marked indicating an objection to the declaration. However, no explanation as to the supposed defect in the declaration is given anywhere in the Action. Applicant has reviewed the declaration and does not find any grounds for objection. Consequently, Applicant respectfully requests clarification that no objection to the declaration exists.

Objection to Drawings:

The Office Action objects to the drawings as being "without labels." (Action of 8/22/07, p. 2). Applicant respectfully disagrees.

37 C.F.R. § 1.83 defines when elements in a patent application drawing are to be "labeled." Rule 1.83 states that "conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the

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invention, should be illustrated in the drawing in the form of a graphical drawing symbol *or a labeled representation (e.g., a labeled rectangular box)*." (Emphasis added).

In contrast, Applicant's drawings do not include any block diagram or any unlabeled "rectangular box" to illustrate a conventional feature that would require a label under the terms of 37 C.F.R. § 1.83. Consequently, the objection to the drawings should be reconsidered and withdrawn.

Prior Art:

Claims 1-6, 9, 10, 20 and 21 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent App. Pub. No. 2002/0109867 to Seseek et al. ("Seseek"). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 1 now recites:

An image reproduction apparatus comprising:
a scanning device;
a transparent scanning bed optically coupled to said scanning device; and
an adjustable shade associated with said scanning bed;
wherein said adjustable shade is configured to be selectively extended from a position adjacent said scanning bed to cover a portion of said scanning bed including from an edge of said scanning bed to a leading edge of said adjustable shade, an underside of said shade presented to said scanning device through said bed being colored such that said scanning device outputs no image when scanning said underside of said shade thereby effectively reducing a size of said scanning bed.
(Emphasis added).

Support for the amendment to claim 1 can be found in Applicant's originally filed specification at, for example, paragraph 0026 and Fig. 2.

In contrast, Seseek does not appear to teach the claimed adjustable shade that is selectively extended to cover a portion of scanning bed *from the edge of the bed to a leading edge of the shade*. Rather, Seseek teaches a scanner with "a plurality of members constructed and arranged to define a scan area on a scanable surface of the scanner, a link for

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communicating with the control interface of the scanner, and a switch for generating a signal to the control interface to initiate and complete a scan of the bounded scan area defined by the plurality of members.” (Sesek, abstract). Accordingly, Sesek teaches pointers (Fig. 3) or bars (Fig. 1) that are only used to define an area to be scanned, *not to cover or shade a portion of the scanning bed from the bed's edge to a leading edge of the shade*, as claimed.

Additionally, Sesek does not appear to teach or suggest “an underside of said shade presented to said scanning device through said bed being colored such that said scanning device outputs no image when scanning said underside of said shade thereby effectively reducing a size of said scanning bed.” Sesek does not teach or suggest the claimed apparatus where an extended shade is part of the area scanned, but is colored so as not to produce any markings in the resulting image. Rather, Sesek teaches an “apparatus, system and method [that] *scans only a user defined enclosed scan area*, instead of the scanning device scanning the entire scanable surface without additional user manipulation.” (Sesek, paragraph 0037) (emphasis added).

Consequently, Sesek fails to teach or suggest the subject matter of amended claim 1. “A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Sesek of claim 1 and its dependent claims should be reconsidered and withdrawn.

Claim 20 now recites:

A scanning device for eliminating unwanted areas of a scanned image, said scanning device comprising:
means for scanning; and

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means for selectively covering edges of a scanning bed such that said means for scanning outputs no image markings when scanning said covered portions of said scanning bed;

wherein said means for covering edges of said scanning bed are configured to selectively reduce an effective scanning area of said means for scanning.
(Emphasis added).

Support for the amendment to claim 20 can be found in Applicant's originally filed specification at, for example, paragraph 0026 and Fig. 2.

In contrast, as demonstrated above, Sesek does not appear to teach or suggest a scanning device like that claimed with "means for selectively covering edges of a scanning bed such that said means for scanning outputs no image markings when scanning said covered portions of said scanning bed." Rather, Sesek teaches means for defining a smaller area within a scanning bed, where only the smaller defined area is scanned.

Consequently, Sesek fails to teach or suggest the subject matter of amended claim 20. "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Sesek of claim 20 and its dependent claims should be reconsidered and withdrawn.

Claims 7, 8, 11-19 and 22-23 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Sesek and U.S. Patent No. 6,695,381 to Schlecht ("Schlecht"). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 11 now recites:

A method of adjusting the target area of an image reproduction apparatus comprising:

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selectively covering an edge of scanning bed by drawing a shade over said edge of said scanning bed;
placing said object on said drawn shade; and
scanning said object
wherein an underside of said shade that is presented to said scanning bed is colored such that said scanning outputs no image of said underside of said shade thereby effectively reducing a size of said scanning bed.
(Emphasis added).

Support for the amendment to claim 11 can be found in Applicant's originally filed specification at, for example, paragraph 0026 and Fig. 2.

In contrast, as demonstrated above, Sesek does not appear to teach or suggest a method of adjusting a target area of an image reproduction apparatus by "selectively covering an edge of scanning bed by drawing a shade over said edge of said scanning bed." Sesek teaches markers for defining an area to be scanned, not for selectively covering an edge of the scanning bed in the manner claimed.

Sesek further does not appear to teach or suggest "wherein an underside of said shade that is presented to said scanning bed is colored such that said scanning outputs no image of said underside of said shade thereby effectively reducing a size of said scanning bed." Rather, as explained above, Sesek teaches means for defining a smaller area within a scanning bed, where only the smaller defined area is scanned.

Schlecht does not remedy any of these deficiencies of Sesek. Schlecht teach a window shade for, e.g., an automobile window. (Schlecht, abstract and Fig. 1). Thus, Schlecht has nothing to do with the claimed method of adjusting a target area of an image reproduction apparatus.

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in

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view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Seseke and Schlecht, did not include the claimed method including “selectively covering an edge of scanning bed by drawing a shade over said edge of said scanning bed” or “wherein an underside of said shade that is presented to said scanning bed is colored such that said scanning outputs no image of said underside of said shade thereby effectively reducing a size of said scanning bed.”

Consequently, claim 11 recites subject matter that is clearly beyond the scope and content of the cited prior art. Therefore, Seseke and Schlecht will not support a rejection of claim 11 or its dependent claims under 35 U.S.C. § 103(a) and *Graham*.

Claim 14 recites:

An optical scanner with an adjustable shade comprising:
a shade reel disposed at an edge of a scanning bed of said optical scanner; and
a shade coupled to said shade reel;
wherein an underside of said shade that is presented to said scanning bed is colored such that said optical scanner does not output any image markings when scanning said underside of said shade thereby effectively reducing a scan target area of said optical scanner.

(Emphasis added).

Support for the amendment to claim 14 can be found in Applicant's originally filed specification at, for example, paragraph 0026 and Fig. 2.

As demonstrated above, Seseke and Schlecht fail to teach or suggest an optical scanner with a shade “wherein an underside of said shade that is presented to said scanning bed is colored such that said optical scanner does not output any image markings when scanning said underside of said shade thereby effectively reducing a scan target area of said optical scanner.” Because this subject matter recited in claim 14 is beyond the scope and content of

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the cited prior art, Seseek and Schlecht will not support a rejection of claim 14 under 35 U.S.C. § 103(a) and *Graham*.

Additionally, Seseek clearly fails to teach or suggest the claimed "a shade reel disposed at an edge of a scanning bed of said optical scanner." This fact is expressly conceded in the Office Action, which states that "Seseek does not disclose a shade reel." (Action of 8/22/07, p. 8). Consequently, the Action cited to Schlecht for the teaching of a shade reel. This proposed combination of the prior art is inappropriate.

"A patent [or patent application claim] composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." According to the Supreme Court, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." (KSR International Co. v. Teleflex, Inc., 550 U.S. ____ (2007)). In the present case, there is absolutely no reason in the prior art, to have combined the teachings of Seseek and Schlecht as proposed in the Office Action.

As explained above, Seseek does not teach means for covering or shading portions of the scanning bed. Rather, Seseek calls for pointers or bars that can be used to outline a desired scanning area. Consequently, there could be no use whatsoever in the Seseek device for a shade reel as recited in claim 14.

Moreover, Schlecht, as noted above, is directed to providing a windup window shade, for example, in an automobile. (Schlecht, abstract and Fig. 1). Thus, Schlecht does not teach or suggest any application for a shade reel on an optical scanner.

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Thus, the combination of Scsek and Schlecht proposed in the Office Action is based entirely on impermissible hindsight. A large number of devices may exist in the prior art where, if the prior art is disregarded as to its content, purpose, mode of operation and general context, the several elements claimed by the Applicant, if taken individually, may be disclosed. However, the important thing to recognize is that the reason for combining these elements in any way to meet Applicant's claims only becomes obvious, if at all, when considered from hindsight in the light of the application disclosure.

The Federal Circuit has stressed that the "decisionmaker must step backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987). To do otherwise would be to apply hindsight reconstruction, which has been strongly discouraged by the Federal Circuit. *Id.* at 1568. Respectfully, "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious"; *Interconnect Planning Corp. v. Fell*, 774 F.2d 1132, 1141, 227 USPQ 543, 550 (Fed. Cir. 1985); *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983).

Therefore, without some reason in the references to combine the cited prior art teachings, with some rational underpinnings for such a reason, the Examiner's conclusory statements in support of the alleged combination fail to establish a prima facie case for obviousness. See, *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ____ (2007)

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(obviousness determination requires looking at “whether there was an apparent reason to combine the known elements in the fashion claimed...,” citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” *KSR* at 14).

Consequently, claim 14 recites subject matter that is clearly beyond the scope and content of the cited prior art. Therefore, Sesck and Schlecht will not support a rejection of claim 14 or its dependent claims under 35 U.S.C. § 103(a) and *Graham*.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the

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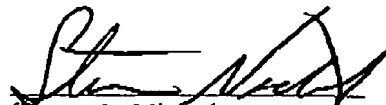
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Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: November 14, 2007


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